

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YONG-TAE JEONG

Appeal 2007-0604
Application 09/576,218
Technology Center 2600

Decided: April 11, 2007

Before JAMES D. THOMAS, JOSEPH F. RUGGIERO and JOSEPH L. DIXON, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 14 through 37. We have jurisdiction under 35 U.S.C. §§ 6(b), 134(a). An oral hearing on this appeal was conducted on April 5, 2007.

Representative independent claim 14 is reproduced below:

14. A method of reducing standby time for printing a system of networked printers connected to at least one host computer, the method comprising:

the at least one host computer registering at least one item of network print information in at least one host computer;

the at least one host computer accessing the network printer information registered in the at least one host computer in response to a command for printing print-data being issued;

the at least one host computer transmitting a request command from the at least one host computer to the networked printers requesting the networked printers to transmit standby print information to the at least one host computer, the standby print information relating to the amount of standby print operations of the respective networked printers;

the at least one host computer determining a minimum-utilized networked printer having a lowest amount of standby print operations from among the networked printers having standby print operations from the standby information transmitted from the networked printers to the at least one host computer in response to the request command; and

the at least one host computer transmitting the print-data from the at least one host computer to the network printer determined to be the minimum-utilized network printer.

The following reference is relied on by the Examiner:

Ishii JP 410116165A¹ May 6, 1998

Claims 14 through 37 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ishii.

¹ The Examiner and Appellant rely on a translation of this document as do we.

Rather than repeat the positions of the Appellant and the Examiner, reference is made to the Brief filed on November 29, 2005 and the Reply Brief filed on January 26, 2006 for Appellant's positions, and to the Answer mailed on January 12, 2006 for the Examiner's positions.

OPINION

For the reasons set forth by the Examiner in the Answer, as expanded upon here, we sustain the rejection of all claims on appeal under 35 U.S.C. §102. The Brief essentially argues independent claims 14, 22, and 30 collectively.

We agree with the Examiner's correlation of each of the specific limitations recited in representative independent claim 14 on appeal at pages 2 and 3 of the Answer, the corresponding remarks at page 5 as to independent claim 22 and the Examiner's slightly expanded position as to independent claim 30 at pages 5 through 7 of the Answer.

The principally disputed teaching is the Examiner's reliance upon the print server 30 in figure 1 and 6 of Ishii correlated to the claimed host computer. We agree with the Examiner's correlation at the bottom of page 3 of the Answer of this server to the host computer because it contains corresponding structure as well as corresponding functions. Appellant's positions in the Brief and Reply Brief that the disclosed invention does not require a print server is misplaced. Ishii merely teaches more than what is claimed and the actual claimed language utilizes the connective "comprising" thus clearly including non-recited elements. That a reference teaches more than what is claimed does not necessarily make it inapplicable to a claimed invention.

Appellant's positions appear to argue the disclosed rather than the claimed invention such as recited in representative independent claim 14 on appeal. The position at the bottom of page 6 of the Brief that "it is inherent in the recitation of claims 14-37 that the at least one host computer performs all of the needed operations of the networked printer system" is misplaced. Clearly, Appellant is inviting us to read the disclosed invention into the subject matter of the claims on appeal. As such, we decline to read into the subject matter of representative independent claim 14 on appeal non recited limitations.

From our perspective, it appears that the printer server in 30 in Ishii figure 1 is shared by all computers 10-13 as well as all printers 20-22. Thus, the artisan may clearly view such server as a controller of each computer as well as of each printer since the server clearly functions to perform the functions corresponding to the disclosed controllers 20 of each host computer as well as the disclosed controller 30 of each printer in figure 2 as disclosed. In these respects then, the statements in the Brief and Reply Brief that no print server is necessary appears to contradict the disclosed invention in the fact that the separate controllers just mentioned are recited in independent claim 30 on appeal. Moreover, it is worthy of note that the print server 30 has a control element 303 within it as shown in figure 6 of Ishii.

Beginning at page 7 of the principal Brief on appeal Appellant mentions various dependent claims but urges patentability of them based upon the assertion that the present or disclosed invention is directed to

eliminating the need for a print server. This view is also misplaced from the perspective that there is no such disclosed disadvantage with respect to the prior art approaches discussed at specification pages 1 through 4 of the disclosed invention. In fact, a print server is not mentioned anywhere in this discussion.

Likewise the common urging that Ishii teaches away from the present invention because it eliminates the need for a print server is equally misplaced because Ishii does not actively discourage the artisan from following the path set out in the claimed invention or lead the artisan in a direction divergent from the path that is encompassed by the subject matter actually claimed. Thus, Appellant's similar arguments with respect to each dependent claim are equally misplaced. The Brief and Reply Brief do not actually contest the Examiner's correlation of the features recited in the noted dependent claims that are taught by Ishii and as argued by the Examiner. A "teaching away" argument is also not appropriate as to anticipation rejections.

The Reply Brief has essentially summarized Appellant's arguments from the Brief that we have already addressed. Of particular note is the Examiner's discussion at pages 9 and 10 of the Answer where the Examiner illustrates that a host computer may be considered to be a server according to a well known computer dictionary, which position has not been contested in the Reply Brief.

In view of the foregoing, the decision of the Examiner rejecting claims 14 through 37 under 35 U.S.C. 102 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR §1.136(a). See 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

PGC

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